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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Otter
Serial No.:	09/738,591
Filed:	December 15, 2001
Group Art Unit:	1762
Examiner:	Parker, Frederick J.
Title:	A METHOD MAKING A FILM WITH IMPROVED WETTABILITY PROPERTIES

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

The following remarks are in reply to the Examiner's Answer dated 21 December 2007. The Appeal Brief fees have already been paid. Any additional fees required may be charged to Deposit Account Number 03-0835 in the name of Carrier Corporation.

REMARKS

Respectfully, the Examiner's Answer raises numerous additional issues that require a brief response as follows.

Regarding Appellant's argument under section II(a) of the Appeal Brief, the Examiner appears to argue that the use of rollers in Takagi and Walling provide a nexus that would lead one of ordinary skill in the art to look to the Takagi reference to achieve a goal of improving on the embedding of particles. Respectfully, Appellant disagrees because the alleged nexus appears to be too far removed from the given goal. The Takagi reference relates to melting a synthetic resin powder using rollers and does not appear to be related at all to embedding particles. Thus, even though both references utilize rollers, one of ordinary skill in the art would not expect to succeed in improving the embedding of particles by using the rollers of Takagi because the rollers in Takagi are used for an entirely different purpose. Therefore, any alleged benefit to embedding particles

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from using of the rollers of Takagi appears to be speculation since Takagi does not teach embedding.

The Examiner also now appears to change the rejection by providing a new reasoning for combining the references. The Examiner argues that incorporating the cooled lower roller of Takagi into Walling would provide the advantage of avoidance of detrimental melting of the substrate while a top surface containing particles remains hot for further processing. As discussed below, Appellant respectfully disagrees that this new reasoning establishes obviousness.

The new reasoning does not provide any explanation of why the alleged advantages would prompt one of ordinary skill in the art to combine the references. For instance, the reasoning only seems to relate to melting the synthetic resin powder in Takagi and does not appear to bear any connection to the references that Takagi is being combined with. For example, avoiding melting of the substrate is a concern in Takagi because the top roller is hot enough to melt the synthetic resin powder. Since synthetic resin powder is not used in the other references, the same concern is not present. Therefore, the given reason of avoiding detrimental melting does not appear to be a reason that would prompt one of ordinary skill in the art to combine Takagi with the other references.

Additionally, it is entirely unclear from the given reasoning what "further processing" would require a hot top surface and cool bottom surface that can allegedly be obtained by using the cooled lower roller of Takagi.

Appellant also notes that the Examiner still has not provided any explanation of how using a cooled lower roller would contribute to improve embedding of particles.

Regarding Appellant's arguments under section II(b)(i) of the Appeal Brief, the Examiner noted Appellant's comment that Walling embeds particles in a polymer substrate. However, whether Walling embeds particles or not does not appear to address any reasons for incorporating the teachings of Takagi into Walling. As discussed above, there is no sound basis for concluding that using the cooled lower roller of Takagi would contribute to improved embedding of particles.

Regarding Appellant's argument under section II(b)(ii) of the Appeal Brief, the Examiner notes that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning and that the Appellant's arguments fail to directly address the Examiner's rationale. Respectfully, Appellant disagrees because the Appeal Brief addresses the Examiner's rationale in section II(b)(i). The argument regarding hindsight is presented for separate

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consideration. Although judgments of obviousness are in a sense a reconstruction based on hindsight reasoning, improper hindsight reasoning is not permitted. In view of the inexplicit reasoning given to support the conclusion of obviousness, the Examiner is clearly using the subject application as a roadmap to combine the references.

Regarding Appellant's argument under section III of the Appeal Brief, the Examiner responds that the function of the particles in the heat exchanger of the Bentley reference was not overlooked. The Examiner contends that the wetting function need not be considered because claim 7 of the present application does not require any specific wetting properties. However, Appellant respectfully disagrees because the issue under an obviousness inquiry is whether one of ordinary skill in the art would combine the cited references. Just as the reasons for combining references are not limited to the problem that the patentee is trying to solve (see *KSR International Co. v. Teleflex Inc.* __ U.S. __, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 2007), the reasons against combining the references should also not be limited. One would not substitute the hydrophobic coating of the Linford reference into the heat exchanger of the Bentley reference because the heat exchanger requires hydrophilicity. Therefore, the wetting should not be overlooked because one of ordinary skill in the art would recognize that the coating of Linford would destroy the operation of Bentley.

Additionally, the Examiner argues that the claimed invention simply combines familiar elements according to their known methods to yield predictable results. Respectfully, Appellant disagrees because the Examiner's comments seem to be conclusory. The rejections do not provide any explicit reasoning relative to "familiarity or predictability" of the claimed elements.

CLOSING

For the reasons set forth above and in Appellant's Appeal Brief, the final rejection of the claims is improper and should be reversed.

Respectfully submitted,

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, fax number (571) 273-8300, on February 21, 2008.

Laura Combs

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